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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/092,739 | 03/07/2002 | Klaus Knoerr | ADI-082 | 7325 |

51414 7590 04/26/2005

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| EXAMINER |
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NAKARANI, DHIRAJLAL S

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| ART UNIT | PAPER NUMBER |
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1773

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/092,739 | Applicant(s) KNOERR, KLAUS | |
| | Examiner D. S. Nakarani | Art Unit 1773 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-16, 18-20, 24 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16, 18-20, 24 and 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-12, 14-16, 18, 19 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed fail to provide support for the limitation "each of the foamed sole element and the support element forming at least a portion of one of the upper side and the lower side of the outer surface of the sole". The Examiner was unable to find support for this limitation in Figure 2 and paragraphs 0026 and 0028 as stated by applicants. Applicants are requested to clearly identify where the support for the afore said limitation can be found in the originally filed specification.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 10-16, 18-20, 24 and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter (U.S. Patent 6,061,929) in view of Tanuma et al (U.S. patent

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4,511,627) for the reasons of record set forth in paragraph 11 of the Office Action mailed July 7, 2003. In addition Ritter discloses a midsole (70) comprising midsole piece (50) having bottom surface (51) and integrally molded midfoot Shank (52). Shank (52) is comprised of EVA foam with a hardness of between 55 and 85 Shore C, while midsole piece (50) is comprised of EVA foam with a hardness of between 30 and 60 Shore C, approximately 20-30 Shore C less than shank (52). Both, midsole piece (50) and shank (52), show upper side and lower side (see Fig. 4, lines 34-67). Ritter fail to disclose that the shank (52) is at least under the portion of a midsole piece (50). Ritter also fail to disclose claimed hardness range of less than about shore D range. Ritter's shank (52) is considered as the support element and midsole piece (50) as foamed element.

However in absence of showing criticality of the limitation "support element disposed below at least a portion of the foamed sole element", it would have been obvious to a person of ordinary skill in the art to which this invention pertains to cover portion of shank (52) with a midsole piece (50) for desired cushioning effect.

5. Applicant's arguments filed January 21, 2005 have been fully considered but they are not persuasive. In reference to rejection of claims under 35 USC 103(a) as being unpatentable over Ritter in view of Tanuma et al, applicant mainly argue that top sole (72) is an element of the entire sole that is separate and distinct from the midsole (70). Conversely, Ritter does not teach or suggest that its midsole includes "a foamed midsole element and at least one support element comprising a common polymer –

based material, the support element being harder than the foamed midsole element and disposed below at least a portion of the foamed midsole element.

Those arguments are unpersuasive because the midsole (70) comprises midsole piece (50) and shank (52) as shown in fig. 4 Ritter's element top sole (72) is equivalent to claimed inner sole in claim 20 Ritter's sole 74 is equivalent to claimed outer sole in claim 20. Ritter does not show claimed "an upper" of the footwear article. However Ritter's footwear sole is for footwear article therefore attaching upper to make shoes, boots or sandals is obvious.

Ritter does not show in fig. 4 that the part of shank (52) is under the midsole piece (50). However placing at least portion of shank (52) is under the midsole piece (50). However placing at least portion of shank (52) under midsole piece (50) is an obvious design choice.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. S. Nakarani/af
April 21, 2005


D. S. NAKARANI
PRIMARY EXAMINER